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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/380,731 09/13/99 RETTENMAIER

J 017309/0173

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IM22/1031

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EXAMINER

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WASHINGTON DC 20007-8696

KIM.S

ART UNIT	PAPER NUMBER
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1723

*21*

DATE MAILED:

10/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/380,731

Applicant(s)

Rettenmaier

Examiner

John Kim

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Oct 10, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-28 and 30 is/are pending in the application.

4a) Of the above, claim(s) 15-28 and 30 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-14 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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1. The request filed on 10/10/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/380,731 is acceptable and a CPA has been established. An action on the CPA follows.

2. Claims 1-2 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,866,242 (hereinafter referred to as Tan et al.). Tan et al teach wood pulp fibers subjected to a dilute alkali metal salt solution at a temperature of from 15 to about 60 degree Celsius and including organic particulates and filter active fractions (see col. 3, line 66 - col. 4, line 7; col. 4, line 58 - col. 5, line 12). Claims 1-2 and 8-9 essentially differ from Tan et al in reciting finely divided wood particles. Wood pulp contains wood fibers, and wood fibers have wood particles. It would have been obvious to a person of ordinary skill in the art to treat wood particles in wood pulp to provide an adsorbent material as suggested by Tan et al.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,288,462 (hereinafter referred to as Hou et al '462) in view of Tan et al. Hou et al '462 teaches filter media sheet comprising cellulose fibers of different pulps or differently beaten pulps and perlite and silica (i.e. kieselguhr) (see col. 3, line 54 - col. 4, line 26; col. 5, line 6 - col. 6, line 36; col. 10, line 64 - col. 11, line 12). Hou et al '462 teach that filter sheet made of cellulose fibers are free of extractables and are free of discoloration (see col. 3, lines 59-69). Claims 1-12 essentially differ from the filter media sheet of Hou et al '462 in reciting claimed treated finely divided wood particles. Tan et al teach wood pulp fibers subjected to a dilute alkali metal salt solution at a temperature of from 15 to about 60 degree Celsius and including organic particulates

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and filter active fractions (see col. 3, line 66 - col. 4, line 7; col. 4, line 58 - col. 5, line 12).

Cellulose pulp contains cellulose fibers, and cellulose fibers have cellulose particles. Cellulose is derived from wood particles. It would have been obvious to a person of ordinary skill in the art to treat wood particles to produce cellulose pulp for its use in a filter media sheet in Hou et al '462.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,488,969 (hereinafter referred to as Hou) in view of Tan et al. Hou teaches filter media sheet comprising cellulose fibers (such as wood pulp, cotton, cellulose acetate or rayon) of different pulps or differently beaten pulps in fiber diameter of 15 to 25 microns and fiber length of about 0.85 mm and perlite and silica (i.e. kieselguhr) (see col. 3, lines 13-27; col. 4, line 57 - col. 5, line 55; col. 9, lines 57-64). Claims 1-14 essentially differ from the material of Hou in reciting claimed treated finely divided wood particles. Tan et al teach wood pulp fibers subjected to a dilute alkali metal salt solution at a temperature of from 15 to about 60 degree Celsius and including organic particulates and filter active fractions (see col. 3, line 66 - col. 4, line 7; col. 4, line 58 - col. 5, line 12). Wood pulp contains cellulose fibers, and cellulose fibers have cellulose particles. Cellulose is derived from wood particles. It would have been obvious to a person of ordinary skill in the art to treat wood particles to produce wood pulp for its use in a fibrous media in Hou.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,599,240 (hereinafter referred to as

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Thompson). Thompson teaches cellulose fibers produced from wood chips cooked and digested at an elevated temperature with a mixture of sodium hydroxide and sodium sulfite solution (see col. 2, lines 7-17). “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

6. Applicant's arguments filed 9/10/01 have been fully considered but they are not persuasive.

Applicant argues that Tan et al. disclose absorbent material instead of the claimed filter aid. However, the intended use of a product does not overcome the product limitation of the material of Tan et al meeting the product by process limitation of claim 1 as recited in paragraph 1 of the prior office action. Applicant argues that Hou et al '462 discloses cellulose fiber and not finely divided wood particles. Claim 2 recites that wood particles are wood fibers and wood fibers encompasses cellulose fibers which are derived from wood.

7. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37

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CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. This application contains claims 15-28 and 30 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (703) 308-2350. The examiner can normally be reached on weekdays from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for official response after final action is (703) 305-3599, and the fax phone number for all other official faxes is (703) 305-7718.

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When sending a draft amendment by fax, please mark the paper as "DRAFT"; otherwise, mark the paper "OFFICIAL". This will expedite the processing of the paper.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



**John Kim**  
**Primary Examiner**  
**Art Unit 1723**

J. Kim  
October 30, 2001